

III. Remarks

A. Status of the Application

Claims 1, 4-13, 15-26, and 28-30 are pending. Claims 1, 4-26, and 28-30 were previously pending. Claim 14 is canceled by the present paper without prejudice to or disclaimer of the subject matter therein. No claims have been added. Reconsideration of this application in light of the above amendments and the following remarks is requested.

B. Premature Finality

As a preliminary matter, Applicant requests that the finality of the present Office Action be withdrawn. As set forth in MPEP §706.07(a):

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)....”

In the present case, the new ground of rejection for at least claim 28 is neither necessitated by an amendment made by the Applicant nor information submitted in a IDS filed under 37 CFR 1.97(c). Specifically, the scope of claim 28 remains as submitted in the Amendment filed on January 10, 2007, and the patent cited as supporting the new ground of rejection was not submitted in a IDS filed during the period set forth in 37 CFR 1.97(c). As noted in Applicant’s previous response, while claim 28 was listed as being rejected in the Office Action Summary of the Office Action mailed March 29, 2007, no rejection of claim 28 was actually provided therein. Accordingly, the finality of the present Office Action is premature and Applicant requests that the finality of the Office Action be withdrawn.

C. Claim Rejections under 35 U.S.C. §103

Claims 1, 4-13, 15-26, and 28-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,598,269 to Kitaevich et al. (“the Kitaevich patent”). Applicant traverses this rejection on the grounds that this reference is defective in establishing a

prima facie case of obviousness with respect to these claims.

As the PTO recognizes in MPEP § 2142:

“... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...”

The Examiner clearly cannot establish a prima facie case of obviousness with respect to claims 1, 4-13, 15-26, and 28-30 using the Kitaevich patent for at least the following reasons.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741 (emphasis added).

In the present case, the Office Action asserts that by rearranging the parts of the Kitaevich patent each of the pending claims 1, 4-13, 15-26, and 28-30 is rendered obvious. However, MPEP §2144.04 clearly notes that:

“The mere fact that a worker in the art **could** rearrange the parts of the reference device to meet the terms of the claims on appeal **is not by itself sufficient to support a finding of obviousness.** The prior art must provide a **motivation or reason** for the worker in the art, **without the benefit of appellant's specification**, to make the necessary changes in the reference device.” Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (emphasis added)

In the present case, no reason or motivation—other than hindsight based on the present invention—has been provided for rearranging the parts of the Kitaevich patent. Instead, the

Office Action simply asserts that it is “a matter of design choice” to rearrange the components of the Kitaevich patent. Specifically, the Office Action asserts that it is “simply a matter of design choice” to take the laser light source 106 of the Kitaevich patent—which is utilized with another laser light source (or split into two beams) in order to produce a fan beam and a point beam for aligning with the CT scan plane 17 and the entry site 26 on the patient's skin, respectively—and move the light source 106 so that it is positioned on the biopsy instrument 100 so that the light shines away from the patient. Applicant respectfully disagrees.

First, the Kitaevich patent teaches away from rearranging the parts as suggested. In that regard, the light sources of the Kitaevich patent are shined on the patient's skin such that they are aligned with the CT scan plane 17 and entry site 26 markings on the patient. For example, the Kitaevich patent states:

Having thus described the structural details of alignment apparatus 30, its method of use will now be described with reference to FIGS. 2 and 3. Alignment apparatus 30 is brought into proximity with a patient 14 having scan plane markings (not shown) on the skin which represent CT scan plane 17. If the CT scan was taken in a vertical plane, then no adjustment of alignment apparatus 30 is required relative to vertical reference plane 64 and the apparatus is maintained in the upright, vertical orientation shown in FIG. 2. However, if a tilted CT scan was taken, alignment apparatus 30 must be adjusted by pivoting plate 40 relative to plate 42 to correspond to the predetermined angle p of the tilted scan. **This will ensure that laser fan beam 74 and laser line beam 76 are coincident with scan plane 17.** Thereafter, housing 56 is tilted such that the angle a , as shown in FIG. 3 and measured by measuring device 62, matches the angle a calculated by CT scanner 10 and shown in FIG. 1A. Then, housing 56 is slid (up or down) along cantilever arm 46 to the appropriate location such that **the visible spot created by laser line beam 76 is pinpointed on the entry site 26 marked on the patient's skin. With this arrangement, the precise angle necessary for the biopsy tool to reach its target 24 is defined by the line beam 76.** Col. 6, ll. 32-54 (emphasis added)

By rearranging the components of the Kitaevich patent such that the laser light sources shine **away** from the patient, this entire function of laser light sources of the Kitaevich patent would be

destroyed. Further, the Kitaevich patent explicitly notes that “[t]he apparatus has no contact with the biopsy tools and thus there is no requirement for sterilization of the device.” Col. 2, ll. 52-54. For at least these reasons, the Kitaevich patent clearly teaches away from rearranging the components as suggested.

Further, it is more than a matter of rearranging the components of the Kitaevich patent for the laser source to be positioned on the biopsy tool as suggested. In that regard, the laser sources of the Kitaevich patent do not appear to be readily attachable to other devices, such as the biopsy tool. Instead, the laser sources as shown in the figures of the Kitaevich patent are positioned within housings and have wired power connections, in addition to being permanently mounted on larger structures such as the alignment apparatus 30 and the mammography machine 140. It is clear that these laser light sources cannot simply be rearranged to be positioned on the biopsy tool as asserted.

For at least these reasons a *prima facie* case of obviousness has not been established with respect to pending claims 1, 4-13, 15-26, and 28-30.

IV. Conclusion

Accordingly, it is believed that all matters set forth in the Office Action have been addressed and that all of the pending claims 1, 4-13, 15-26, and 28-30 are in condition for allowance. A formal notice of allowance of the pending claims is requested.

Respectfully submitted,



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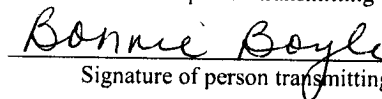
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